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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,348	11/20/2001	Daniel Levy	COR 130 US	1363

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EXAMINER

BERCH, MARK L

ART UNIT PAPER NUMBER

1624

DATE MAILED: 05/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/989,348	LEVY ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Mark L. Berch	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2004.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 24-33 and 42-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-26, 28-31 and 33 is/are rejected.
- 7) ☒ Claim(s) 27, 32 and 42-46 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/26/04</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 2/26/04 has been entered.

### *Claim Rejections - 35 USC § 102*

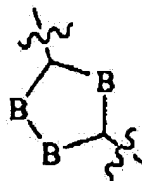
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 24-26, 28-31, 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Fauland.

The reference corresponds to this choice for A:



The B on the right is oxygen, the other two are both CH(OH), corresponding to R<sup>1</sup> = H, R<sup>2</sup> = -O-J<sup>5</sup>-R<sup>8</sup>, where J<sup>5</sup> is a bond and R<sup>8</sup> is H. With q as zero, L and Y disappear. The compound at column 2, line 55 corresponds to the second Z choice, example 1 to the

third Z choice, and example 10 to the first Z choice. All of the other remaining examples presumably qualify as prodrugs.

Claims 24-26, 28-31, 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamashita.

See Formula I in column 1. The analysis is the same as above, except that one B is CH(OH) and the other is CH(NH<sub>2</sub>) or CH(alkanoylamino), corresponding to -J6-R9 as H, and -J7-R10 as amino or alkanoylamino respective. In the formula of the reference, R1 as the first choice amino gives the adenine, R3 as either choice will give the second Z choice or a prodrug thereof, and either R2 choice will give amino or alkanoyl amino. The alkanoyl groups are named at column 8, lines 21-22, corresponding to R10 as alkyl. Note in particular (Ia) which has the amino, (Ih) which shows the unprotected adenine, and (Ii) which shows the carboxy choice. The compounds of the claims are thus clearly conveyed.

Claims 24-26, 28-31, 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Olsson.

See column 2, compounds 9-11. The analysis is the same as in the Fauland rejection above, with these compounds corresponding to the second, third and 4<sup>th</sup> Z choices. Compounds 12-14 would be prodrugs, as would be compounds 1-5 and 8.

Claim 24 is rejected under 35 U.S.C. 102(b) as being anticipated by Baker.

See XXIX. This corresponds to A = phenyl, Y = 3<sup>rd</sup> choice, m = 1, J1 = carbonyl, Z = second choice with m = 0.

Claims 24-26, 28-31, 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Prasad.

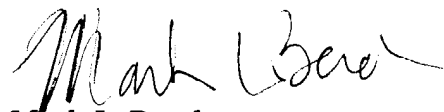
The analysis is the same as in the Fauland rejection above, with these compounds corresponding to the prodrugs (the esters) of the first Z choice.

Claims 27, 32, 42-46 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark L. Berch whose telephone number is 571-272-0663. The examiner can normally be reached on M-F 7:15 - 3:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on (571)272-0674. If you are unable to reach Dr. Shah within a 24 hour period, please contact James O. Wilson, Acting-SPE of 1624 at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Mark L. Berch  
Primary Examiner  
Art Unit 1624